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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,651	02/19/2004	Hsin-Ti Su	MR1683-528	2185
4586	7590	04/06/2006	EXAMINER	
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			AFTERGUT, JEFF H	
			ART UNIT	PAPER NUMBER
			1733	
DATE MAILED: 04/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Cm

Office Action Summary	Application No.	Applicant(s)	
	10/780,651	SU, HSIN-TI	
	Examiner	Art Unit	
	Jeff H. Aftergut	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of El-Fakir et al or Whitehorn further taken with any one of the state of the prior art, Japanese Patent 1-229700 or Kaiser, Jr..

Either one of El Fakir or Whitehorn suggested that it was known at the time the invention was made to apply glitter to a pencil barrel in the manufacture of a decorated pencil. Both references taught the steps of applying a glue to the periphery of a barrel of a pencil followed by the application of a reflective layer whereby multiple glitters are adhered to the exterior of the pencil barrel via the glue layer. Onto the exposed glitter layer, the reference s suggested that a transparent overcoat was applied to the same. The applicant is more specifically referred to Whitehorn where the pencils 1 from the pencil hopper 2 were fed through a clear lacquer stage where glue was applied to the pencils 1 with pot 3 followed by passing the lacquer coated pencils through a glitter application device at glitter pot 5. After passing through the glitter pot 5 the reference taught that a second clear lacquer was applied with a second lacquer pot 3. The reference to El-Fakir suggested the application of an adhesive coat to the pencils 10 as at 26 followed by the application of glitter 30 to the pencil bodies. After the glitter has been applied, the reference taught that one applied another coat of adhesive and/or

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lacquer to the pencil body as at 42 in order to better adhere the glitter 30 to the pencil bodies. The assembly was then passed through an oven to cure the adhesive material. The references both taught that it was well known at the time the invention was made to employ a lacquer coating as an adhesive for attachment of a glitter material to a pencil body. The references suggested that such glitter application was used for decoration of the pencil bodies. The references failed to teach that one skilled in the art at the time the invention was made would have applied a printing onto the pencil body subsequent to the glitter application (i.e. a patterning to provide a vivid appearance to the pencil).

The references to any one of the state of the prior art, Japanese Patent 1-229700 or Kaiser, Jr. suggested that those skilled in the art at the time the invention was made would have known to apply a decorative printing and/or coating upon the pencil body. More specifically, it is taken as conventional to the state of the prior art to provide various painting and or printings upon a pencil body in order to decorate the same. Such was commonplace in the art of pencils in order to render the same desirable for those using the same. Such is taken as conventional in the art and applicant is hereby given notice of the same. To provide conventional coatings and. Or printings upon a pencil in order to provide markings upon the same would have been known to the ordinary artisan and would have been used in the processing of either one of El-Fakir or Whitehorn. The applicant is advised that those skilled in the art would have understood that the making of a pencil with indicia (like No. 2 and the specific manufacturer of the pencil) was likewise well known in the art to provide the desired finish to the pencil. Japanese Patent '700 suggested that it was known to provide a pencil with an printing

of a design or indicia thereon whereby the desired pattern was applied to the pencil in a cost effective and pleasing manner. The reference to Kaiser suggested that those skilled in the art would have known to provide colored coatings about the exterior of the pencil barrel in order to provide the same with the desired decoration thereon. Clearly, it would have been within the skill level of the ordinary artisan to provide a decoration about the exterior of the pencil wherein the same was provided with the desired indicia thereon as well as the desired decorations as suggested by any one of the state of the prior art, Japanese Patent 1-229700 or Kaiser, Jr. wherein the pencil barrel was provided with a glitter decoration thereon as suggested by either one of El-Fakir et al or Whitehorn.

With respect to claims 2 and 5, note that the references to either one of El-Fakir et al or Whitehorn suggested that one skilled in the art would have employed transparent glue and that the transparent glue was dried to form the transparent layers which were used both to coat the barrel prior to glitter application as well as to overcoat the glitter after glitter application. Regarding claims 3 and 6, the specific amount of resin in the lacquer is taken as conventional in the art of making pencils and one skilled in the art of lacquers would have known that such conventional transparent lacquers included 8-15 percent resin therein. Regarding claim 4, note that a cartridge was centrally contained within the barrel of the pencil assemblies of the references discussed above.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 1-2, it is suggested that "the flowing steps" be deleted from the claim as there is no antecedent basis for any steps having been performed. Claim 1 is not in good English. For example, on lines 3-4, the language "gluing: an outer periphery of a barrel of the pencil being allover glued for forming a glue layer" should be rewritten to --applying glue all over a periphery of a barrel of the pencil to form a glue layer thereon--. Likewise on lines 5-6, the language "forming a reflective layer: multiple glitters being fully adhered onto the outer periphery of the barrel to form a reflective layer;" should be changed to --forming a reflective layer by applying glitter to the glue layer--. It should be noted that these are merely examples and that all of the claims include language which is not deemed clear and concise under 112, second paragraph. Care should be taken to rewrite the claims in proper form.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeff M. Aftergut
Primary Examiner
Art Unit 1733

JHA
April 2, 2006